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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,578	11/19/2003	Nnochiri N. Ekwuribe	9233.8DV4	6296

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EXAMINER

GITOMER, RALPH J

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/716,578

Applicant(s)

EKWURIBE ET AL.

Examiner

Ralph Gitomer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53-55, 58 and 64-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: SEQUENCE ERROR REPORT

The amendment received 12/20/04 has been entered and claims 53-55, 58, 64-82 are currently pending in this application. The Terminal Disclaimer has been accepted. The sequence listing has not been accepted, see the attached error report for an explanation.

In view of the amendments to the claims and arguments presented, the rejections of record under 35 USC 112, first and second paragraphs, are hereby withdrawn. And the Terminal Disclaimer overcomes the obviousness double patenting rejection. The parent file 09/134,803 remains unavailable.

The rejection of claims 53-55, 58, 64-82 under 35 U.S.C. 102(a) at being anticipated by Ekwuribe (5,681,811) is maintained.

Applicant's arguments filed 12/20/04 have been fully considered but they are not persuasive.

Applicants argue that the present claims specify the modified enkephalin peptide must retain analgesic activity where Ekwuribe does not describe the specific advantages of the coupled oligomers.

It is the examiner's position that the present claims are directed to providing a compound and the compounds claimed are taught by Ekwuribe for the same function. Regarding any advantages of the compound, the activity of a compound is inherent in the compound. No method of producing any results is claimed, merely providing known compounds. Note that an enkephalin is a peptide.

The rejection of claims 53-55, 58, 65-82 under 35 U.S.C. 103(a) at being unpatentable over Ekwuribe (6,191,105) is maintained.

Applicant's arguments filed 12/20/04 have been fully considered but they are not persuasive.

Applicants argue that Ekwuribe does not recite the presently claimed specific compounds.

It is the examiner's position that Ekwuribe teaches the presently claimed conjugated enkephalins. The changes in binding affinity due to the conjugation would be inherent in the compound.

The rejection of claim 58 under 35 U.S.C. 103(a) as being unpatentable over the combination of Ekwuribe in view of Shashoua is maintained.

Applicant's arguments filed 12/20/04 have been fully considered but they are not persuasive.

Applicants argue that not all the limitations of claim 53 are taught by Ekwuribe.

It is the examiner's position that Ekwuribe teaches the presently claimed conjugated enkephalins.

The rejection of claim 64 under 35 U.S.C. 103(a) as being unpatentable over the combination of Ekwuribe in view of Dooley is maintained.

Applicant's arguments filed 12/20/04 have been fully considered but they are not persuasive.

Applicants argue that that not all the limitations of claim 53 are taught by Ekwuribe.

It is the examiner's position that Ekwuribe teaches the presently claimed conjugated enkephalins.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ralph Gitomer whose telephone number is (571) 272-0916. The examiner can normally be reached on Monday - Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ralph Gitomer
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Art Unit 1651

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